

REMARKS

The foregoing amendments and these remarks are in response to the Office Action dated March 7, 2011. Applicant respectfully requests a two month extension of time. Authorization is given to charge the appropriate fees to Deposit Account No. 50-0951.

At the time of the Office Action, claims 1-12 were pending in the application. In the Office Action, objections were raised to the drawings and claims 1-37. Claims 1-12 were rejected under 35 U.S.C. §102(e) and claims 1, 3, 5, 11, and 13-37 were rejected under §103(a). The objections and rejections are discussed in more detail below.

I. Objections to the Drawings

The drawings were objected to because they were alleged to be blurry and indistinct. Corrected drawing sheets in compliance with 37 CFR §1.121(d) are filed herewith, and are believed to correct all the deficiencies. Withdrawal of the objection is respectfully requested.

II. Rejections to the claims under 35 U.S.C. §112

Claims 1-37 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the claims were alleged to be replete with grammatical and idiomatic errors, and to include numerous antecedent basis problems. Appropriate corrections to the claims to correct these issues are included herewith, and withdrawal of the rejections is respectfully requested.

III. Rejections to the claims based upon art

Claims 1-12 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0187555 to Biedermann et al. (hereafter "Biedermann"). Claims 1, 3, 5, 11, and 13-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,488,684 to Bramlet et al. ("Bramlet") in view of Biedermann.

Amendments to the claims are filed herewith. Amended claim 1 derives from original claims 1 and 3, and some additional minor amendments. It has now been made clear that the stem recited in claim 1 is made of two half-cylinders that are axially united along their lengths. Claim 16 includes some minor amendments and clarifies that each insert is made of a plurality of metallic foils stacked onto each other and consisting of shape-memory material.

Amended claim 19 derives from original claims 20-23 and includes some additional minor

amendments. Claim 19 now requires that the shape-memory elements are structurally independent from the stem, and that the jacket and the stem can be shifted with respect to each other along a longitudinal axis of the stem from a first operative position in which the side wall of the jacket retains the shape-memory elements in the first configuration of rest, and a second operative position in which the transversal holes of the jacket are aligned with the seats of the stem, so as to allow the arrangement of the shape-memory elements projecting from the respective seats. The claim also recites that a control screw, suitable to be rigidly connected to a head portion of the stem, causes an axial shift of the stem with respect to the jacket when the control screw is rotated around its own axis.

Biedermann discloses an intramedullary nail comprising a stem 2 provided with three longitudinal grooves 5 that extend parallel to a stem axis "M". Three plates 60 with a cross-section matching that of the grooves are inserted into said grooves in a sliding fashion (Fig. 9a). Figures showing cross sections of the stem clearly indicate that the stem is made of one single piece (see Figs. 3, 14, and 15). Therefore, amended claim 1 is not anticipated by Biedermann.

Bramlet discloses an intramedullary nail comprising a stem that is shown in Fig. 4B, which is an enlarged partial cross section of Fig. 4A (see page 4, line 37). Fig. 4a is in turn a longitudinal cross section. Therefore, the stem of the intramedullary nail disclosed in Bramlet is made of a single piece.

Bramlet discloses an intramedullary nail comprising along the length of the nail multiple sets of four tang portals 5. Each tang portal is made of a stainless steel alloy or a titanium alloy. Fig. 4B only shows how the tang portals can be arranged along the stem. Nothing is said in Bramlet about the way each tang portal is realized.

The Office Action incorrectly considers the cannulated nail body 1 of Fig. 4B of Bramlet to represent a tubular jacket and the tag leading protrusions 18 of the tag assembly 2 to form a stem. In this case, both the stem (leading protrusions) and the tang portals 5 are made of the same components, therefore one cannot say that the stem (the tag leading protrusions 18 of the tag assembly 2) is structurally independent from the tag portals. In contrast, amended claim 19 requires that the shape-memory elements are structurally independent from the stem. Therefore, amended claims 1, 16, and 19 are patentable over Bramlet in view of Biedermann.

For the foregoing reasons, the independent claims are believed to relate to patentable

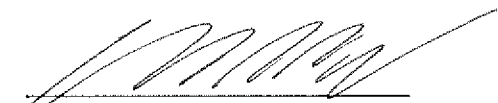
subject matter, and to be in condition for allowance. The dependent claims are believed allowable because of their dependence upon an allowable base claim, and because of the further features recited.

IV. Conclusion

Applicant has made every effort to present claims which distinguish over the prior art, and it is thus believed that all claims are in condition for allowance. Nevertheless, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. In view of the foregoing remarks, Applicant respectfully requests reconsideration and prompt allowance of the pending claims.

Respectfully submitted,

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